UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

    A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

  1)☒ Responsive to communication(s) filed on <u>11 July 2008</u>.

  2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

  3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
       closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

  4)☒ Claim(s) <u>1,3,5 and 7</u> is/are pending in the application.

      4a) Of the above claim(s) _____ is/are withdrawn from consideration.

  5)☐ Claim(s) _____ is/are allowed.

  6)☒ Claim(s) <u>1,3,5 and 7</u> is/are rejected.

  7)☐ Claim(s) _____ is/are objected to.

  8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

  9)☒ The specification is objected to by the Examiner.

  10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

      Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

      Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

  11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

  12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is in reply to Applicant's response filed on 11 July 2008 to the first office action.

2.   Claims 2, 4 and 6 have been cancelled.

3.   Claims 1, 3 and 5 have been amended.

4.   All pending Claims 1, 3, 5 and 7 of this application have been examined.

Response to Arguments

5.   Regarding the 35 U.S.C. § 103(a) rejection of Claims 1, 3, 5 and 7 applicant argues *"Neither Redlich, Bray, nor Thompson teach, disclose, or suggest "embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document," as recited in claim 1."* The Examiner respectfully disagrees, the quoted "…retrieved character string…" is actually in the dependent Claim 2 and furthermore the objective of Claim 1 is to locate "a character string which should not be disclosed for some reason" and to replace that string with a meaningless character string. The character string and the reason for non-disclosure are as stated in Claim 1 "stored in a dictionary located in an auxiliary storage unit." Redlich in at least paragraph [0045] discloses establishing a group of security sensitive words, characters, icons, data streams or data objects and are subsequently used by a level of filters to extract the sensitive words and store them in another location. The storage location being dependent on whether the computer is a stand-alone or networked system. Therefore Claims 1, 3, 5 and 7 are properly rejected and remain rejected.

6.   Applicant further argues that *"Redlich is not "embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document," as recited in claim 1."* The Examiner respectfully disagrees and notes that per applicant's specification (Figures 9, 10 and 11) the embedded tag is a comment statement whose contents are not visible when the message is displayed; in Redlich the tags

(placeholders) can be visible or invisible. Redlich in at least paragraph [0060] discloses that the critical content is extracted and/or encrypted. Redlich in at least paragraph [0091] further discloses that the system inserts security level tags corresponding to the security sensitive words/objects, etc. and inserting placeholders into the remainder data which mark the location of the extracted data (security sensitive words). Redlich in at least paragraphs [0174 and 0177] further discloses that a replacement of the extract (sometimes called a placeholder) can also be substituted on-the-fly to provide updated results, misinformation, dis-information, messages, alerts, links (to reports, data mining, search engines, web sites, and hyperlinks understood in the current art), advertisements, and personalization and customization to create altered versions of the original document. Therefore Claims 1, 3, 5 and 7 are properly rejected and remain rejected.

7.   Applicant further argues that *"Redlich has no "compulsory disclosure dictionary," as recited in claim 1."* The Examiner respectfully disagrees; Redlich does not call it a "compulsory disclosure dictionary." However Redlich in at least paragraph [0021] discloses multiple filter levels which limit full reconstruction and enabling partial reconstruction of the extracted data and the remainder or common data, therefore whenever moving from a higher to a lower security level the extracted data which is reconstituted performs the same functions as a "compulsory disclosure dictionary." Redlich in at least paragraphs [0174 and 0177] further discloses that a replacement of the extract (sometimes called a placeholder) can also be substituted on-the-fly to provide updated results, misinformation, dis-information, messages, alerts, links (to reports, data mining, search engines, web sites, and hyperlinks understood in the current art), advertisements, and personalization and customization to create altered versions of the original document. This process of replacing the extracted data with the various types of data is also compulsory in nature. Therefore Claims 1, 3, 5 and 7 are properly rejected and remain rejected.

8.   Applicant further argues that *"Pointing to an external subset containing markup declarations or can contain the markup declaration directly in an internal subset, however, does not amount to replacing a character string by a meaningless character string when a document is retrieved, let alone "replacing, in the original document, a character string <u>which is contained in the non-disclosure dictionary and not contained in the compulsory disclosure dictionary, with a</u>*

meaningless character string by using the tag of non-disclosure." As recited in claim 1." The

Examiner respectfully disagrees, the underlined portion is not supported in Applicant's Specification, as

disclosed in paragraph [0037] of Applicant's Specification the character string search is a serial process,

where the search begins with the first character string (if there's one) in the non-disclosure dictionary and

continues until all the strings in the non-disclosure dictionary are exhausted and then progresses to the

compulsory disclosure dictionary where the first character string is read (if there's one) and compared

with the document.

Priority

9.   Acknowledgment is made of applicant's claim for foreign priority based on an application filed in

Japan on 27 September 2002. It is noted, however, that applicant has not filed a certified copy of the

Japanese application as required by 35 U.S.C. 119(b).

Specification

10.   The amendment filed 11 July 2008 is objected to under 35 U.S.C. 132(a) because it introduces

new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter

into the disclosure of the invention. The added material which is not supported by the original disclosure

is as follows: *"replacing, in the original document, a character string which is contained in the non-*

disclosure dictionary and not contained in the compulsory disclosure dictionary, with a

meaningless character string by using the tag of non-disclosure." As recited in claim 1." Applicant

is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

11.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and

process of making and using it, in such full, clear, concise, and exact terms as to enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make

and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12.   **Claims 1, 3, and 5** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. ***"replacing, in the original document, a character string <u>which is contained in the non-disclosure dictionary and not contained in the compulsory disclosure dictionary</u>, with a meaningless character string by using the tag of non-disclosure." As recited in claims 1, 3 and 5."***

Claim Rejections - 35 USC § 103

13.   **Claims 1, 3, 5, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Redlich et al. (US Pub 2005/0132070 A1) henceforth known as Redlich in further view of Bray and Thompson.

Claim 1, 3, 5 and 7:

With regard to the limitations:

- *Parsing a document with regards to a non-disclosure dictionary containing a character string and a reason for replacement.*
- *Converting original document to an XML formatted document and providing an auxiliary storage unit.*
- *Embedding a tag in place of the character string.*
- *Replacing the character string with a meaningless character string when the document is retrieved.*
- *Meaningless character string is obtained from compulsory dictionary.*

Redlich in at least paragraph [0163] and Fig.1A discloses passing or parsing (Redlich, paragraph [0042]) a source document (data object) through a filter. The data object may be, e.g., test, images, icons, moving images, multiple images, data representing sound, video, etc. and is

broadly defined as any item that can be represented in an electronic format and can be manipulated by a computer. The filter in the simplest sense separates uncommon text (remained data) from common text where text can be words, characters, icons or data objects and may be performed when the data object is created, saved, periodically, automatically, per user command, etc.(paragraph [0172]). The security sensitive words, characters, icons or data objects (Redlich, paragraphs [0034 and 0045]) are separated from remained or common word "text" and may utilize a dictionary. Redlich in at least paragraph [0060] discloses that the critical content is extracted and/or encrypted. Redlich in at least paragraph [0091] further discloses that the system inserts security level tags corresponding to the security sensitive words/objects, etc. and inserting placeholders into the remainder data which mark the location of the extracted data (security sensitive words). Redlich in at least paragraph [0170] further discloses enhancing the program's ability to locate security sensitive words or characters by using a properly dissected telephone book, a compilation of scientific words, or words unique to a certain industry, or country. Redlich in at least paragraphs [0174 and 0177] further discloses that a replacement of the extract (sometimes called a placeholder) can also be substituted on-the-fly to provide updated results, misinformation, dis-information, messages, alerts, links (to reports, data mining, search engines, web sites, and hyperlinks understood in the current art), advertisements, and personalization and customization to create altered versions of the original document. Redlich in at least paragraph [0164, 0165, 169, and 0239] and Fig.19 further discloses additional features or options (security levels, multiple storage areas, and encryption and decryption routines) which one or more filters may contain with regards to text extraction and replacement.

Redlich in at least paragraph [0054] discloses that the present invention may also be configured to automatically secure structured documents and transactional documents like database records or XML documents (input documents). Redlich in at least paragraph [0045, 0047, and 0166] and Fig.1A discloses storing the common text or the remainder data in common storage memory or computer storage locations.

Redlich in at least paragraph [0274] discloses the automatic separation of data objects within a data stream into two or more digital data streams according to the importance and categorization of contents, through extraction and removal of the prioritized content and its replacement by appropriate placeholders (paragraph [0222]) with the intent of customizing of selected contents within a data stream to different parties. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to recognize that parsing a document through a filter with extensive capabilities to search and separate strings of text based on some filter rules or characteristics is similar to applicant's use of a dictionary to contain a character string that will be searched and replaced with an embedded tag.

Redlich does not explicitly disclose the character string being replaced by a meaningless character string when a document is retrieved per se. However, Bray in at least page 3 discloses the structure of XML documents and the use of an XML processor to read XML data and in at least page 9 (last 3 lines) defines an XML document type declaration that provides a grammar for a class of documents. The grammar is known as a document type definition (DTD) that can point to an external subset containing markup declarations or can contain the markup declaration directly in an internal subset, or can do both (Bray, page 10). Thompson in at least page 1 defines an XML Schema (extends the capabilities of DTDs) which offers facilities for describing the structure and constraining the contents of XML documents when they are retrieved or displayed. Therefore, it would be obvious at the time of the invention, to one of ordinary skill in the art to recognize that by parsing (retrieving) XML documents along with the DTD and or Schema and changing the appearance of particular data is a standard feature when using and retrieving XML documents; and any results are not unpredictable.

Conclusion

14.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

10 October 2008

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627